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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,359	03/16/2001	Taeyoung Yoon	49662 [72021]	7721

21874 7590 07/11/2003

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BOSTON, MA 02209

EXAMINER
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TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/11/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/811,359

Applicant(s)

YOON ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-16 is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 8 and 17-68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### FINAL ACTION

Applicant's amendment of 4-24-03 has been fully considered. Although the amended claims and applicant's argument have overcome the rejections of new matter and 112/2<sup>nd</sup> paragraph, said argument has not overcome the 103 rejection based on **Murata et. al.** Thus, said rejection is maintained herein. Also, the amended claim 3 has raised new ground of rejection which is presented below.

Claims 1-68 are still pending.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 3, 5, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by **Murata et. al.** (US 5,972,946). On column 29, Murata et. al. disclose compounds 22-27 which are embraced by the formula in claim 3 with the following substituents:

- a.  $R_1$  (corresponds to the reference's  $R_6$ ) represents an alkyl group;
- b.  $R_2$  (corresponds to the reference's  $R_5$ ) represents  $-XR_A$ , with X as  $-CH_2-$ , and  $R_A$  as hydrogen;
- c.  $R_3$  (corresponds to the reference's Cl) represents halogen.
- d.  $R_C$  (corresponds to the reference's  $R_7$ ) represents halogen, haloalkyl, alkoxy group.

Thus, the reference's compounds read on all limitations of the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Murata et. al.** (US'946). The rejection is maintained for the reasons stated in the previous action, and for the following one:

e. Applicant asserts that there is no motivation for one skilled in the art to substitute another halogen for the Cl of compounds 22-30. However, applicant's attention is directed to the generic formula (II') on column 14, in which Z<sub>1</sub> is defined as a halogen. Thus, clearly the teaching of Murata et. al. allows for other halogen-substituted pyrimidinyl compounds, and not just 4-Cl-pyrimidinyl.

f. Applicant's argument of "easy to make" for compounds 22-30 is not quite understood. Just because a compound is easy to make does not mean one skilled in the art would not have the motivation to make it. Compounds 22-30 are **useful as an intermediate with a halogen leaving group**, which lends sufficient motivation for the skilled chemist to make such a compound, and use it in another process.

g. Applicant has not provided unexpected result for Br, F, and I over Cl as a leaving group. Applicant has not shown why one would prefer Br, F, I over Cl in the instant compounds. Without unexpected superior result, the prima facie case of obviousness based on the teaching of Murata et. al. remains outstanding.

***Claim Objections***

3. Claims 4, 7, 8, and 17-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references of record do not read on the particular compounds or methods recited in said claims.

***Allowable Subject Matter***

4. Claims 9-16 are allowed. Again the references of record do not read on compounds in said claims.

***Reference cited on PTO-892***

5. The reference, US 2002/0052387, discloses some intermediates (formulae VI and VII) which seem relevant to the compounds claimed herein. However, the effective filing date of said reference does not antedate the priority date of the instant application. Thus, said reference is not a competent prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

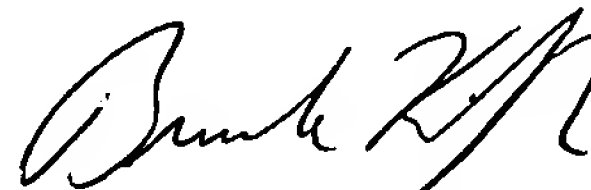
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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July 8, 2003



BRUCK KIFLE, PH.D.  
PRIMARY EXAMINER